REMARKS

Claims 1-25 are pending in the application.

The present claims are directed to multilayer decorative sheets. The sheets comprise (a) a clear coat having a first and second surface, (b) a tie coat layer on the second surface of the clear coat, (c) a fade print layer on the tie coat layer and (d) a pressure sensitive adhesive layer on the fade print layer. Opacity of the fade print layer reduces over the width of the decorative sheet. When used on a vehicle, the vehicle's color under the decorative sheet is revealed.

Present Office Action rejects claims 1-6, 8-10 and 16 under 35 U.S.C. §103(a) as obvious over Johnson et al. (US Patent 5, 518,786) alone or in view of Ellison (US Patent 5,985,079). The Office Action indicates that the color layer of Johnson et al. is used for decorative purposes and that a fade coat or fade print layer is inherently one type of color coat. The Office Action states that it is conventional and clearly within the skill of the art to print a fade print as a color coat. Ellison is cited as teaching methods of applying decorative effects such as printing, tinting, etc. It is considered by the Examiner to be obvious to print Ellison's color design as a fade print coat in Johnson's decorative sheet. The alleged motivation is the desire to provide decorative fade color designs.

Johnson et al. relates to exterior automotive laminate, pressure sensitive adhesive sheets. Johnson et al. teaches a clear coat layer, tie coat layer, and a color coat. The color coat has adhesive applied to its back surface to adhere the surface to an automotive vehicle. Johnson et al. teaches, at column 11, lines 16-17, that the color coat is preferably cast directly onto the tie coat layer, as opposed to forming a color coat as a separate film and then laminating it to the tie coat.

Johnson et al. seeks to find beneficial ways to eliminate the painting steps carried out in the manufacturing of conventional automobiles (See Johnson et al Field of the

Invention). Johnson et al. teaches that the painting process traditionally used for painting automobiles involves spraying and dipping. These processes provide a single color to the article. Johnson et al. seeks to replace regular paint coat with an exterior automotive laminate. Further, Johnson et al. does not teach or suggest a fade print layer. Johnson et al. teaches that the color coat layer is preferably coated onto the tie coat layer. There is no teaching or suggestion within Johnson et al. about how to make or a fade coating or that a fade print coating would be desirable.

The present Office Action indicates that the use of a fade print layer is considered to be inherently a type of color coat. There is no specific evidence provided in the Office Action or scientific argument that would indicate that this statement is other than the Examiner's belief. In particular, there is no teaching or suggestion within Johnson et al. that would lead one of skilled in the art to believe that a fade print layer is inherent within a generic description of a color laminate. In particular, Johnson et al. does not teach a process to make the fade print layer or a desire to make such a fade print layer. In order for inherency to apply in a rejection, the property must necessarily result and not possibly result. In this case, there is no teaching in Johnson et al. that would lead one skilled in the art that a fade print layer would necessarily result from the color coat layer of Johnson et al. The reference, not Applicants' specification, must contain a teaching that would lead a skilled person to determine that the fade print layer necessarily will result from a color coat. Such disclosure is lacking in Johnson et al.

It is improper for an Examiner to use hindsight analysis in rejecting Applicants' claims. In particular, Johnson et al. and the other references do not teach or suggest a fade print layer as claimed by Applicants. None of the references teach or suggest a change of opacity across a decorative sheet. Johnson et al. and the other references fail to provide motivation for one of ordinary skill in the art to make a fade print layer. Johnson

et al. does not contain disclosure that would teach one of ordinary skill in the art how to make the fade print layer.

The current Office Action also cites Ellison as teaching methods of applying decorative effects. Ellison relates to flexible composite surfacing films and methods for producing the same. Ellison teaches a flexible composite surfacing film for providing a substrate with a desired surface characteristic. The film comprises a flexible temporary carrier film and a flexible transparent outer polymer clear coat layer releasably bonded to a temporary character film, and a flexible outer polymer layer comprising extruded thermoplastic polymer. A pigmented base coat is adhered to the outer clear coat layer and is visible throughout. The Office Action cites the paragraph at column 7, line 54-58 as teaching that the decorative effects may be applied by processes such as printing, tinting, vacuum metallizing, vacuum metallizing with tinting or vacuum metallizing with hologram printing.

Ellison does not make up for the previously described deficiencies of Johnson et al. In particular, Ellison et al. provides no motivation for one of skill in the art to produce a fade print layer. Ellison does not teach or suggest fade print layers as decorative effects. In addition, there is no teaching or suggestion in Ellison how one would produce a fade print layer. Therefore, Ellison does not provide any motivation to modify Johnson to make a fade print layer. Therefore, Applicants submit that claims 1-6, 8-10 and 16 are unobvious over Johnson et al. alone or in combination with Ellison.

The Office Action rejects claims 11-15 and 17-25 under 35 U.S.C. § 103 as being unpatentable over Johnson et al. in view of Carroll Jr. (US Patent 5,192,609).

Carroll et al. relates to a thermoformable sheet material comprising a carrier film having a dark base coat layer and over the base coat layer, a transparent layer which contains light reflective metallic flakes and over the metallic flake layer a clear top coat layer.

Carroll et al. does not teach or suggest the fade print layer. Carroll et al. does not make up for the deficiencies already described for Johnson et al. There is no motivation in Johnson et al. or Carroll Jr. to produce a fade print layer. Applicants, therefore, submit the claims 11-15 and 17-25 are patentable over Johnson et al. in view of Carroll Jr.

Claim 7 stands rejected under 35 U.S.C. §103 as being unpatentable over Johnson et al. alone or in view of newly cited Alexander (US Patent 4,533,704). The Office Action admits that Johnson does not specifically teach that the clear coat is a polyester film. The Office Action then indicates that it is believed a clear coat with polyurethane modified polyester from automobile exterior coating is well known and within the skill of the art. Alternately, the Office Action cites Alexander as teaching a clear coat coating system with excellence adherence to metal or plastic substrates. The clear coat composition of Alexander is a hydroxy containing urethane modified polyester.

Claim 7 is directed to a multilayer decorative sheet wherein the clear coat layer is a polyester. As previously indicated by the Examiner, Johnson et al. does not teach a polyester clear coat layer. There is no basis provided by the Office action to determine that a polyester is well know for automotive applications. Applicants request the Examiner to provide evidence to support the assertions in the Office Action. Without some teaching that would lead a person skilled in the art to modify Johnson et al with a polyester clear coat, Applicants submit that the claim is not rendered obvious by Johnson et al. Furthermore, the the earlier described deficiencies of Johnson et al have not been addressed. Applicants still submits that Johnson et al deos not teach or suggest a fade print layer.

Claim 7 is also rejected under the combination of Johnson et al. in view of Alexander et al. Alexander relates to a flexible base coat/clear coat coating system which comprises a hydroxy containing urethane modified polyester as a clear coat and a hydroxy containing urethane polyester and pigment as the base coat. The Office Action indicates

that the motivation for combining Alexander et al. with Johnson et al. is the desire to make a clear coat system with lower cost.

Alexander et al. relates to a flexible base coat/clear coat coating composition which allegedly provides superior weathering properties as well as adhesion to metal and plastics. Improved weathering is claimed for the clear coat composition. Applicants fail to find any disclosure in Alexander et al. for the cost benefits of using a polyester urethane. Applicants submit that there is no evidence of record for suggesting that Alexander et al teaches a cost benefit to using polyesters. Further, even if such disclosure exists, Alexander et al. does not teach or suggest a fade print layer. Therefore, Alexander et al. would provide not motivation to modify Johnson et al. to use a fade print layer for the color coat. Applicants submits that the Office Action has failed to provide a basis for a combination of Johnson et al. with Alexander et al. Therefore, it is submitted that the claims are not obvious over Johnson et al. in view of Alexander et al.

In view of the above comments, the Applicants submit that the present claims are not obvious over the references of record. Applicants request the Examiner to withdraw the rejections and allow the claims.

In the event any issues remain in the prosecution of this application, Applicants request the Examiner call the undersigned attorney to expedite allowance of the claims. If any fees are required for the filing of these papers, Applicants request the Commissioner to charge those fees to Deposit Account #18-0988.

Respectfully submitted,

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